



**UNITED STATES DEPARTMENT OF COMMERCE**

**Patent and Trademark Office**

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/368,817 08/05/99 GARBER

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EXAMINER

MM91/1019

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I.E.U.

ART UNIT

PAPER NUMBER

2876

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

|                              |                 |               |  |
|------------------------------|-----------------|---------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 09/368,817      | GARBER ET AL. |  |
|                              | Examiner        | Art Unit      |  |
|                              | Uyen-Chau N. Le | 2876          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 5) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2-16</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

### *Claim Objections*

2. Claims 11, 15 and 27 are objected to because of the following informalities:

Re claim 11, line 2: Substitute "LAV" with -- library automation vendors (LAV) --.

Re claim 15, line 2: Substitute "it" with -- the display --.

Re claim 27, line 2: Substitute "elements" with -- element --.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-6, 23, 36-41, and 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Cannon et al (EP 0,494,117 - cited by the applicant).

Re claims 1-2, 4-6, 23, 36-41, and 43-47: Cannon et al discloses a method of using a hand-held RFID device for reading information from an RFID element to identify and locate an item. The RFID device comprising (a) an interrogation source for obtaining information from an RFID element associated with an item; (b) an indicator for indicating information regarding a desired location for that item, wherein the indicator provides at least one of an audible and a visual indication, wherein the information of step (b) is obtained from memory within the RFID device, separated from the RFID device by upload, from the tag on the item. The method comprising the steps of providing a card having an RFID element; transmitting information to the card and storing that information in the RFID element; positioning RFID card readers at positions near the item; interrogating the RFID card with the RFID card reader; providing an indication of the location of the item relative to the location of the RFID card reader, wherein the item is a library material and the larger group of items comprises other library materials; providing a visual display of the location of the item; displaying information regarding the location of the item; and the information is provided to the RFID device by a manual keypad (figs. 1-6; col. 2, line 28 through col. 4, line 52; col. 5, line 58 through col. 6, line 41).

5. Claims 7, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Dlugos, Sr. et al (US 5,153,842 - cited by the applicant).

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Re claims 7, 10, and 12: Dlugos Sr. et al discloses a method of using an RFID device comprising the steps of (a) interrogating an optical bar code associated with an item to obtain information about that item; (b) storing that information on an RFID element to create a tag for the item; and (c) obtaining additional information about the item and storing that information on the RFID element, wherein the information is obtained visually from the item and is entered into the RFID device manually (col. 11, line 14 through col. 12, line 35).

6. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Guthrie (US 5,565,858 - cited by the applicant).

Re claim 13, Guthrie discloses a method of obtaining information from a group of items having RFID elements associated therewith, comprising the steps of interrogating the items to determine information about their identity; organizing the identification information in a predetermine order; and providing an output indicative of that order (fig. 3; col. 3, line 62 through col. 5, line 12; and col. 7, lines 3-14).

7. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanfield et al (US 5,739,765 - cited by the applicant).

Re claims 17-19, Stanfield et al disclose a method of identifying a specific item having an RFID element associated therewith from among a larger group of items comprising the steps of providing an RFID interrogation device with information identifying the specific item wherein the information is information identifying a class of items; interrogating the larger group of items; providing a signal when the RFID device interrogates the RFID tag associated with the specific item, wherein the class of items are items belonging in the same section of the library (fig. 15; col. 4, lines 24-55; col. 7, lines 33-63; col. 15, lines 20-33; and col. 16, lines 59-65).

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8. Claims 26-27, 29, and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Engellenner (US 5,786,764 - cited by the applicant).

Re claims 26-27, 29, and 34-35: Engellenner discloses a method of using an RFID device for identifying and locating items having an RFID element associated therewith; comprising providing information to the RFID device identifying a location; interrogating the items with the RFID device to determine the identity of the items; associating the items with the location; interrogating an RFID element associated with a location; displaying the items and their respective locations; and downloading the information associating the items with the location to a computer, wherein the items are library materials (figs. 1-2; col. 7, lines 41-59; col. 8, lines 50-56; and col. 11, lines 57-65).

9. Claims 48-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Ricketts (US 5,218,344 - cited by the applicant).

Re claims 48-49, Ricketts discloses a method of monitoring the use of an area, comprising the steps of providing prospective users with an RFID card; providing RFID readers at one location in proximity to the area; interrogating RFID cards in the area using the RFID readers; and providing a signal indicative of the presence of RFID card in proximity to the RFID reader, wherein the area is at least part of a library (figs. 1-2; col. 6, lines 15-33; and col. 7, line 60 through col. 9, line 49).

10. Claim 50 is rejected under 35 U.S.C. 102(b) as being anticipated by Loosmore et al (US 5,682,142 - cited by the applicant).

Re claim 50, Loosmore et al a method of monitoring the use of an area, comprising the steps of providing prospective users with an RFID card; providing RFID readers at one location in proximity to the area; interrogating RFID cards in the area using the RFID readers; and providing a signal indicative of the presence of RFID card in proximity to the RFID reader, wherein the signal includes information as to

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the user to whom the RFID card registered, and access to the area may be permitted or denied to that user (fig. 3; col. 2, lines 5-48; col. 9, lines 57-60; and col. 10, lines 56-65).

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowers et al (US 5,963,134 - cited by the applicant).

Re claim 20, Bowers et al discloses a method of using an RFID device comprising the steps of interrogating an item having an RFID element associated therewith; inputting information to the device to describe a location; determining whether the interrogated item belongs at the location; and providing an appropriated signal; scanning the RFID element associated with a location and that the item is a library material, and the location is a library storage location (col. 7, lines 30+; col. 8, lines 15+; and col. 8, lines 35+).

### *Claim Rejections - 35 USC § 103*

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of

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each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al in view of Bowers et al (US 5,963,134 - cited by the applicant).

Re claim 3, Cannon et al have been discussed above but fails to teach or fairly suggest that the device is portable and adapted for carriage and hand-free used by a person.

Bowers et al teaches the above limitation with a portable RFID scanner 42 being used in figs. 1 & 9; col. 8 lines 1+; and col. 15, lines 30+.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bowers et al into the teachings of Cannon et al in order to provide Cannon et al with a more compact system, wherein the operator does not have to be too concerned with holding/carrying a bulky/heavy device and also accomplishing other tasks at the same time (e.g., taking notes, carrying others books/items, etc.), and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Cannon et al, well within the ordinary skill in the art, and therefore an obvious expedient.

15. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos, Sr. et al in view of Cannon Jr. et al (US 5,689,238 - cited by the applicant). The teachings of Dlugos, Sr. et al have been discussed above.

Re claims 8 and 9: Dlugos, Sr. et al have been discussed above but fails to teach or fairly suggest that the method further including the step of providing an adhesive on the tag, wherein the adhesive is a reposition-able adhesive.



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Cannon Jr. et al teaches the above limitation with an electronic tag 15 can be glued to an object/item and also can be peel-off (col. 2, lines 15-30, especially lines 21-24).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cannon Jr. et al into the teachings of Dlugos, Sr. et al in order to provide Dlugos, Sr. et al with a more feasible system wherein the tag can be peel off and attached to the correct object/item in the event that the tag is attached to a wrong object/item. Furthermore, such modification would have been an obvious extension as taught by Dlugos, Sr. et al, well within the ordinary skill in the art, and therefore an obvious expedient.

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos, Sr. et al in view of Bowers et al. The teachings of Dlugos, Sr. et al and Bowers et al have been discussed above.

Re claim 11, Dlugos, Sr. et al have been discussed above but fails to teach or fairly suggest that the additional information is obtained from library automation vendors (LAV) software having a database including information about the item.

Bowers et al teaches the additional information is obtained from the database via library automation vendors software, which is inherently being used in the library fig. 4; col. 9, line 55 through col. 11, line 65.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bowers et al into the teachings of Dlugos, Sr. et al in order to provide Dlugos, Sr. et al with a more user-friendly system, wherein more details information about the desired item can be retrieved. Furthermore, such modification would provide the operator an alternative of viewing the item's information prior to finding the items, preventing unwanted books/items/articles being realized after being found, and thus saving the operator's time. Accordingly, such modification

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would have been an obvious extension as taught by Dlugos, Sr. et al, well within the ordinary skill in the art, and therefore an obvious expedient.

17. Claims 14-16 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie in view of Ruppert et al (US 5,640,002 - cited by the applicant). The teachings of Guthrie have been discussed above.

Re claims 14-16 and 24-25: Guthrie has been discussed above but fails to teach or fairly suggest that the output is an interactive visual or auditory display; the operator can provide input to the display in order to control the display; the output is a paper listing.

Ruppert et al teaches the above limitation with output information being displayed on the touch screen 12 in form of paper listing and the operator can control the display by pressing button 14 or using the touch box 16 of the touch screen 12 (figs. 37-38; col. 6, lines 16-57; col. 8, lines 11-14; col. 21, lines 63-66; col. 32, lines 9-20; col. 40, lines 5-30; and col. 41, lines 1-17).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ruppert et al into the teachings of Guthrie in order to provide Guthrie with a more user-friendly system, wherein the user has the ability of controlling the information display to further display the desired information of that particular item. Therefore, such modification would have been an obvious extension as taught by Guthrie, well within the ordinary skill in the art, and therefore an obvious expedient.

18. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engellenner in view of Guthrie. The teachings of Engellenner and Guthrie have been discussed above.

Engellenner has been discussed above but fails to teach or fairly suggest that the method further includes the step of arranging and interrogating the items in a series, so that the RFID device can determine the location of one item with respect to other items.

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Guthrie teaches the above limitation in col. 11, lines 14-18 (e.g., the desired tag is located three tags underneath the master tag).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Guthrie into the teachings of Engellenner in order to provide Engellenner a more accurate and organized system, which would provide the operator the exact location of that desired item being sought. Furthermore, such modification would help the operator to locate and find the desired item readily, and thus providing a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Engellenner, well within the ordinary skill in the art, and therefore an obvious expedient.

19. Claims 30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engellenner in view of Frich (US 6,074,156). The teachings of Engellenner have been discussed above.

Engellenner has been discussed above but fails to teach or fairly suggest that the location is a cart and the method further comprising passing the RFID device into the cart, and wherein the location includes a shelf having an antenna associated therewith.

Frich teaches the above limitation with book cart 200 having titling mean 300 in fig. 1; col. 3, line 38 through col. 4, line 41; especially col. 4, lines 34-41.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Frich into the teachings of Engellenner in order to provide Engellenner a more accurate system, wherein the operator can only identify and locate items that are shelved but also can find items that are awaited for shelving (i.e., the returning/new items being placed on the cart(s) before moving to their respective shelving locations, etc.). Furthermore, such modification would help the operator to locate and find the desired item readily by providing him/her with the exact location of the desired item, and thus a more user-friendly system. Accordingly, such modification would

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have been an obvious extension as taught by Engellenner, well within the ordinary skill in the art, and therefore an obvious expedient.

20. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engellenner as modified by Frich as applied to claim 26 above, and further in view of Ghaffari et al (US 5,708,423 - cited by the applicant). The teachings of Engellenner as modified by Frich have been discussed above.

Re claim 31, Engellenner as modified by Frich have been discussed above but fails to teach or fairly suggest that the method further comprising the step of passing the cart through a tunnel.

Ghaffari et al teaches the above limitation with tunnel 84 in fig. 4; col. 6, lines 27-57.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ghaffari et al into the teachings of Engellenner/Frich in order to provide Engellenner/Frich with a quicker and easier way of determining items' location without checking each and every item individually. Furthermore, such modification would provide Engellenner/Frich with a more user-friendly system by saving time and requiring less arduous labor. Accordingly, such modification would have been an obvious extension as taught by Engellenner/Frich, well within the ordinary skill in the art, and therefore an obvious expedient.

21. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al in view of Marsh et al (EP 0,494,114 - cited by the applicant). The teachings of Cannon et al have been discussed above.

Re claim 42, Cannon et al have been discussed above but fails to teach or fairly suggest that the visual display comprising a map of the area including the item.

Marsh et al teaches the above limitation with a map being generated on the display in col. 7, lines

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It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Marsh et al into the teachings of Cannon et al in order to provide Cannon et al with a more high tech system, wherein the operator/user is provide with all of the necessary information in the clearest way (i.e., the map direction) of the sought item/object, through which the operator will find the ease in identifying and locating the item/object, and thus providing a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Cannon et al, well within the ordinary skill in the art, and therefore an obvious expedient.

### *Conclusion*

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Gombrich et al (US 4,835,372) and Wiklof et al (US 6,056,199) are cited as of interest and illustrate a similar structure to a radio frequency identification systems applications.


23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-T and TR-F 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-4783 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Uyen-Chau N. Le

October 15, 2001

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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